

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREJ KOCEV, SAMUEL H. DUNCAN, and STEVEN HO

Appeal 2007-1498
Application 09/944,776
Technology Center 2100

Decided: September 7, 2007

Before ROBERT E. NAPPI, JEAN R. HOMERE, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's Final Rejection of claims 13 through 36, 40, and 41. Claims 37 through 39 have been allowed. Claims 1 through 12 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) to decide this appeal.

II. ILLUSTRATIVE CLAIM

Claim 15 is illustrative of the invention. It reads as follows:

15. A system for programmably allocating resources to accommodate I/O transactions at I/O ports of a multiprocessor computer system, the system comprising:

means for determining the number of devices being serviced via a port, at least one assembly identified for hot swapping,

means for copying the contents of cache memories associated with the at least one identified assembly,

means for setting criteria for transactions at the port with respect to the number of devices, and

means, responsive to the criteria, for assigning resources to the ports.

III. PRINCIPLE OF LAW

When the terms in the claims are written in a “means-plus-function” format, one interprets them as the corresponding structure described in the specification or the equivalents thereof consistent with 35 U.S.C. § 112, paragraph 6. *In re Donaldson*, 16 F.3d 1189, 1193, 29 USPQ 1845, 1848 (Fed. Cir. 1994)(en banc). To assist in interpreting means plus function claims on appeal Appellants are to provide a mapping of the structure disclosed in the specification to the claimed “means.” Rule (37 C.F.R. § 41.37(c)(1)(v)(2005))¹ states:

¹ We cite to the version of the Code of Federal Regulations in effect at the time of the Appeal Brief.

A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

IV. ANALYSIS

Here, claims 15, 16, 19, and 20 comprise means-plus-function elements. On page 11, of the Brief, Appellants separately address the Examiner's rejection of claim 15.

In addressing the cited claims, the *Summary of the Claimed Subject Matter*, on pages 3 and 4 of the Brief, Appellants cite to Figures 7, 8 and pages 3 through 13 of the Specification. Particularly, at pages 3 and 4 of the Brief, Appellants' Summary states the following:

Independent claim 15 is directed to a system for allocating resources to accommodate I/O transactions at the I/O ports of a multiprocessor computer. The system includes means for determining the number of devices being serviced by the I/O ports (see pp. 3 and 9-10, and Figs. 7-8), an assembly for hot swapping (see pp. 5-6 and 11, and Fig. 3), means for copying the contents of cache memories associated with the assembly to be hot swapped (see pp. 3 and 3-13, and Figs 7-8), means for setting criteria for transactions at the I/O ports with regard to the

number of devices determined to be serviced thereby (see p. 10 and Figs 7, 8 and 10B), means for assigning resources to the I/O ports, whereby the assigning means are responsive to the criteria (see p. 10 and Figs 7, 8 and 10B).

The cited portions of the Specification generally discuss the determination of the number of devices being serviced at a port, the copying of contents of cache memory, the setting of criteria for transactions at the port, and the assignment of resources to the ports. (Specification 3, 5-13.) The *Summary*, however, fails to particularly identify (by page and line numbers in the Specification and by reference characters in the drawings) which of the disclosed structures actually correspond to the claimed “means for” (1) determining, (2) copying, (3) setting, and (4) assigning. The Specification does not clarify this ambiguity. Consequently, we decline to substitute speculation about where the structures corresponding to the claimed subject matter are described in the application for the greater certainty that should come from Appellants. Accordingly, Appellants’ Brief does not comply with 37 C.F.R. § 41.37.

V. ORDER

Accordingly, we REMAND this application to the Examiner to:

- (1) send to Appellants a notice of non-compliance of the Second Amended Appeal Brief, identifying the above noted deficiency and requiring Appellants to submit a revised Appeal Brief.
- (2) further evaluate the Brief for compliance with 37 C.F.R. § 41.37, and

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(3) for such further actions as may be appropriate.

REMANDED

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